

REMARKS

The Office Action mailed April 8, 2004 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1, 2, 5-22, 24-39, and 41 are now pending in this application. Claims 2, 3, 23, and 40 have been canceled. Claims 1-41 stand rejected. Claims 42 and 43 are newly added.

Applicant wishes to thank Examiner for courtesies extended to the Applicant and Applicant's representatives during a telephonic interview conducted May 6, 2004. During the interview, the independent claims were discussed in view of Borghesi et al. (U.S. Pat. No. 5,950,169), Frankel et al. (U.S. Pat. No. 6,449,661), and Burchetta et al. (U.S. Patent No. 6,330,551). During the interview, the Examiner requested additional limitations be added to the claims to describe the claimed invention more clearly.

The rejection of Claims 1, 2, 5-22, 24-39, and 41 under 35 U.S.C. § 103 as being unpatentable over Borghesi et al. in view of Frankel et al. (U.S. Pat. No. 6,449,661), and further in view of Burchetta et al. (U.S. Patent No. 6,330,551) is respectfully traversed.

Borghesi et al. describe a system 28 used by members of an insurance provider for managing and processing insurance claims work flow for claims filed by insured owners. The system includes at least one remote computer located at various locations within the insurance provider, including an insurance home office 30, a local claims office 32, and an auditor 34. Each computer 30, 32, and 34 is coupled to a communication server 36. The server maintains a database all information relating to a given claim, including vehicle inspection data, damage estimates, repair estimates, and salvage disposition information. Moreover, the system includes a total loss information tab that contains information on total loss valuation such as general vehicle by year, model, etc. The total loss value is an estimated value assigned to a damaged vehicle to generally determine if the cost to repair exceeds the total value of the vehicle.

If the total loss value is greater than an estimate of the repair, then a decision may be made to repair a damaged vehicle. Thus, the total loss value is used to help determine whether the insured vehicle is repaired, or whether an owner of the vehicle is paid a settlement value for the vehicle. More specifically, the system enables an internal user of the insurance provider, such as a claims adjuster, a repair technician, or another member of the

insurance provider, to compare estimated costs between original manufactured parts and recycled parts by selecting an estimate tab. Notably however, such information is not downloaded to the insured owner, but rather is used internally by the insurance providers to determine whether the insured vehicle is repaired, or whether an owner of the vehicle is paid a settlement value for the vehicle.

Frankel et al. describe a business model for maintaining a database of missing/stolen items and missing persons/fugitives. Within the model, a user accesses the database through an Internet portal and either posts information or inquires regarding stored information. In one embodiment, an automated recovery flowchart 100 is implemented, in which a user may seek missing/stolen items. In another embodiment, information regarding the missing/stolen item is entered as used as the basis for a competitive bidding process 405 used to procure the lowest bid through an auction, in which the lowest bid is automatically selected as the source for the replacement item. Notably, Frankel et al. do not describe nor suggest downloading information to enable an insured user, external to the insurance provider, to select a replacement item.

Burchetta et al. describe a computerized system for automated dispute resolution through an Intranet website via the Internet or other communications linkage 1 for communicating and processing a series of demands to satisfy a claim made by or on behalf of a person involved in a dispute with at least one other person and a series of offers to settle the claim. The computer matches the settlement offer against the claimant's demand and performs programmed calculations to determine a settlement. If the demand and offer intersect in accordance with preestablished conditions, settlement is reached. If the demand is less than or equal to the offer, then the case is settled at a settlement amount equal to the demand. If the demand exceeds the offer, the system splits the difference between the demand and offer, if the offer is within a preestablished percentage, for example 70% of the demand. If 70% of the demand is still greater than the offer, there is no settlement unless the difference between the demand and offer is less than a preestablished amount, for example \$5,000, in which case the claim is settled for the median amount between the demand and the offer.

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some

teaching, suggestion, or incentive supporting the combination. None of Borghesi et al., Frankel et al., or Burchetta et al. considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Frankel et al. and Burchetta et al. with Borghesi et al. because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicant's own teaching. Rather, only the conclusory statement that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teachings of Borghesi to include the feature of downloading information related to the product and displaying the downloaded information so that the user can quickly and easily obtain the desired information" suggests combining Borghesi et al. and Frankel et al. However, the insured in Borghesi is not a user of the system and combining Frankel et al. with Borghesi et al. would require a significant change to the operation of the system described by Borghesi et al.

Further, the only suggestion to combine Burchetta et al. with Borghesi et al. as modified by Frankel et al. is the conclusory statement, "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teachings of Borghesi et al. as modified by Frankel et al. to include the feature of allowing the insured user to interact for selecting one of the settlement offers so that the insured user would be pleased with the outcome." However, the user in Burchetta et al. does not select the settlement offer, a computer algorithm computes a settlement based upon demands and offers entered into the computer by parties involved in an adversarial dispute. Furthermore, Borghesi et al. describes that shop personnel or junkyard personnel select the parts to be used in repairing an insured customer's car. To have an insured customer select parts to be used to repair the insured customer's car would require a knowledge level of automobile repair much greater than is described in Borghesi et al. Accordingly, there appears to be no motivation to combine the cited references that is found neither within the references themselves nor in the skill in the art at the time the invention was made.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine

such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Borghesi et al. is cited for its teaching of a method for replacing an insured item using a web-based system, Frankel et al. is merely cited for its teaching of including the feature of downloading information related to the product, and Burchetta et al. is cited for allowing the insured user to interact for selecting one of the settlement offers. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejection be withdrawn.

In addition, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None of Borghesi et al., Frankel et al., nor Burchetta et al., considered alone or in combination, describe or suggest a server that downloads product information about a replacement jewelry item to the insured user to enable the insured user to select a replacement item from the downloaded product information.

If art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed

invention. Moreover, Applicants respectfully submit that Burchetta et al., Frankel et al., and Borghesi et al., teach away from the present invention, and as such, there is no suggestion or motivation to combine Frankel et al. and Burchetta et al. with Borghesi et al. to produce the claimed invention. Specifically, in contrast to the present invention, Frankel et al. describes a system in which an insured user may either seek missing/stolen items, or attempt to replace the items through a competitive bidding process in which the lowest bid is automatically selected as the source for the replacement item, and in further contrast to Frankel et al. and to the present invention, Borghesi et al. describes a system which enables an insurance provider to maintain and track a claim through the insurance process without enabling the insured user to select a replacement item during the claim process. Burchetta et al. teaches that a user enters a demand or offer, which if determined by computer algorithm, meets predetermined criteria, a settlement amount is calculated. As such the user does not select a replacement offer or a settlement price, but rather has a settlement price calculated by a computer.

Accordingly, and to the extent understood, no combination of Borghesi et al., Frankel et al., and Burchetta et al. describes or suggests the claimed invention. Specifically, Claim 1 recites a method for replacing insured items of an insured user using a web-based system including a server and at least one device connected to the server via a network, wherein the method includes “receiving at the server, from the insurer, specification information about the item to be replaced via the device...comparing the received item specification information with potential replacement product information pre-stored within the server...selecting at least one potential replacement product which matches the received item specification information...downloading item feature information, product accessory information, and a price quote related to the selected potential replacement product...storing the selected potential replacement options in a database for access by at least one of the insured user and the insurer...approving, by the insurer, at least one of the potential replacement product options, whose information was downloaded...displaying the downloaded information to the insured user via the device...prompting the insured user to select at least one replacement item from the downloaded information.”

None of Borghesi et al., Frankel et al., nor Burchetta et al., considered alone or in combination, describe or suggest a method for replacing insured items of an insured user using a web-based system including a server and at least one device connected to the server via a network, wherein the method includes receiving at the server, from the insurer,

specification information about the item to be replaced via the device, comparing the received item specification information with potential replacement product information pre-stored within the server, selecting at least one potential replacement product which matches the received item specification information, downloading item feature information, product accessory information, and a price quote related to the selected potential replacement product, storing the selected potential replacement options in a database for access by at least one of the insured user and the insurer, approving, by the insurer, at least one of the potential replacement product options, whose information was downloaded, displaying the downloaded information to the insured user via the device, and prompting the insured user to select at least one replacement item from the downloaded information.

Specifically, no combination of Borghesi et al., Frankel et al., and Burchetta et al. describes or suggests a method wherein the system prompts the insured user to select at least one replacement item from the downloaded information.

Rather, in contrast to the present invention, Borghesi describes a system wherein an insurer or an insurer's agents select replacement parts, Frankel et al. describes a system wherein the user browses through all items in the database and not a pre-selected matching portion of the database, and Burchetta et al. describes a system wherein a computer algorithm selects a settlement amount based on users' input.

For at least the reasons set forth above, Claim 1 is submitted to be patentable over Borghesi et al. in view of Frankel et al., and further in view of Burchetta et al.

Claims 2, and 5-20 depend from independent Claim 1. When the recitations of Claims 2 and 5-20 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2 and 5-20 likewise are patentable over Borghesi et al. in view of Frankel et al.

Claim 21 recites a system for facilitating selection of an item by an insured user to replace an insured jewelry item of the insured user. The system comprises "a device...a server connected to said device and configured to receive specification information data about the jewelry item to be replaced via said device, the information including at least one of a feature of the item, an accessory of the item, and a price quote, said server further configured to identify stored product information data that matches item specification

information data entered into the server, download potential replacement product information, and store potential replacement product options to a database accessible to at least one of the insured user and the insurer for approval, and to display the product information for the pre-selected and approved potential replacement products to the insured user to enable the insured user to select a replacement item from the downloaded product information.”

None of Borghesi et al., Frankel et al., nor Burchetta et al., considered alone or in combination, describe or suggest a system for facilitating selection of an item by an insured user to replace an insured jewelry item of the insured user, wherein the server is configured to receive specification information data about the jewelry item to be replaced via the device, the information including at least one of a feature of the item, an accessory of the item, and a price quote, the server further configured to identify stored product information data that matches item specification information data entered into the server, download potential replacement product information, and store potential replacement product options to a database accessible to at least one of the insured user and the insurer for approval, and to display the product information for the pre-selected and approved potential replacement products to the insured user to enable the insured user to select a replacement item from the downloaded product information.

Specifically, no combination of Borghesi et al., Frankel et al., and Burchetta et al. describes or suggests a system configured to display the product information for the pre-selected and approved potential replacement products to the insured user to enable the insured user to select a replacement item from the downloaded product information.

Rather, in contrast to the present invention, Borghesi et al. describe a system that is used by internal users of an insurance provider to manage and process insurance claims work flow for claims filed by insured owners regarding their insured vehicles and does not download information and is not configured to enable an insured user, external to the insurance provider, to select a replacement item, however it is the insurer or the insurer's agents that select the replacement parts, Frankel et al. describe a system wherein the user browses through all items in the database and not a pre-selected and approved matching portion of the database, and Burchetta et al. describes a system wherein a computer algorithm selects a settlement amount based on users' input.

For at least the reasons set forth above, Claim 21 is submitted to be patentable over Borghesi et al. in view of Frankel et al., and further in view of Burchetta et al.

Claims 22, 24-39, and 41 depend from independent Claim 21. When the recitations of Claims 22, 24-39, and 41 are considered in combination with the recitations of Claim 21, Applicant submits that dependent Claims 22, 24-39, and 41 likewise are patentable over Borghesi et al. in view of Frankel et al., and further in view of Burchetta et al.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 1, 2, 5-22, 24-39, and 41 be withdrawn.

With respect to newly added Claims 42 and 43, Claims 42 and 43 each recite a limitation regarding pre-approving at least one of the potential replacement products, whose information was downloaded, by the insurer. None of Borghesi et al., Frankel et al., nor Burchetta et al., considered alone or in combination, describe or suggest the insurer pre-approving at least one of the potential replacement products, whose information was downloaded. Furthermore, Claim 42 depends from Claim 1 which is submitted to be in condition for allowance. When the recitations of Claim 42 are considered in combination with the recitations of Claim 1, Applicants submit that Claim 42 likewise is in condition for allowance.

Claim 43 depends from Claim 21 which is submitted to be in condition for allowance. When the recitations of Claim 43 are considered in combination with the recitations of Claim 21, Applicants submit that Claim 43 likewise is in condition for allowance.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Robert B. Reeser', is written over a horizontal line.

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